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RR# 10  
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EXAMINER

CASTELLANO, STEPHEN J

ART UNIT

PAPER NUMBER

3727

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Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/872,914

Applicant(s)

SCHERMEL, FERDINAND

Examiner

Stephen J. Castellano

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1, 3-7 and 9-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3-7 and 9-23 is/are rejected.
- 7) ☒ Claim(s) 1, 3-7 and 9-23 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 June 2001 and 24 April 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_ 6) ☐ Other: \_\_\_\_

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Applicant submitted a request for supervisory review filed February 3, 2003 as paper No. 23 which has been treated as a request for reconsideration and the request for continued examination (RCE) filed October 9, 2002 as paper No. 15 has been granted. Claims 2 and 8 have been canceled. An action on the merits of claims 1, 3-7 and 9-23 follows:

### ***Claim Renumbering***

Preliminary amendment C has been entered and the claims have been appropriately renumbered.

The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 4.5 and 5.5 have been renumbered as claims 22 and 23, respectively.

### ***Manner of Making Amendments***

Applicant must double space the lines of any text being added by amendment whether the text is in the written specification, the claims or an abstract. Also, applicant must use an appropriately sized lettering such as 12 point or larger as the size used is too small to decipher punctuation when a facsimile copy is transmitted. Also, applicant should submit amendments in accordance with 37 CFR 1.121. As of yet, applicant still doesn't follow the appropriate procedure set forth in 37 CFR 1.121 after repeated instruction for the examiner and other office personnel.

### *Specification*

The use of the trademark RUBBERMAID has been noted in this application. It should be capitalized wherever it appears (capitalize every letter) and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

The examiner suggests that appropriate generic terminology for the term RUBBERMAID could be "a plastic trash receptacle."

### *Drawing Objections*

The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on April 24, 2002 as a portion of amendment A filed on April 24, 2002 have been disapproved because they introduce new matter into the drawings. 37 CFR 1.121(f) states that no amendment may introduce new matter into the disclosure of an application. The original disclosure does not support the showing of five containers attached together as shown in Fig. 1.

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the modular wheeled container system comprising a wheeled container, a first attachable container which rest on top of the wheeled container and a second attachable container which rest on top of the first attachable

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container as claimed in claim 1 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

In addition, all of the limitations of claims 3-7, 9, 10, 13-20, 22 and 23 must also be shown in the same figure or corresponding figures. For claim 11, no container which increases an effective volume of a wheeled container is shown. All containers have a constant volume rather than an expanding or contracting volume. For claim 12, the combination of a wheeled container, a first attachable container and a plurality of second attachable containers which are not the first attachable container or the wheeled container is shown.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Claim Objections***

Claims 1, 3-7, 9, 10, 12, 22 and 23 are objected to because of the following informalities: Claim 1 recites structure pertaining to a modular wheeled container system comprising a wheeled container, a first attachable container which rest on top of the wheeled container and a second attachable container which rest on top of the first attachable container which has not been shown in the drawings.

Claims 11 and 12 are objected to because of the following informalities: Claim 11 claims a container which increases an effective volume of a wheeled container which has not been shown in the drawings. All containers have a constant volume rather than an expanding or

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contracting volume. Although the wheeled container's volume is constant, the volume of the modular container system increases as containers are added.

Appropriate correction is required. Appropriate correction may include the cancellation of the claim(s) or the removal of the objectionable portion of the claim(s). Do not submit new matter.

### *112 Rejections*

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 3-7, 9, 10, 13-20, 22 and 23 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification as originally filed doesn't contain support for a modular wheeled container system comprising a wheeled container, a first attachable container which rests on top of said wheeled container and a second attachable container which rests on top of said first attachable container. **This is a new matter rejection.**

Claims 11 and 12 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification doesn't adequately teach a container which increases effective

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volume of a wheeled container. All containers have a constant volume rather than an expanding or contracting volume. Although the wheeled container's volume is constant, the volume of the modular container system increases as containers are added.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 3-7 and 9-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 21 and 22 do not have a period to appropriately define the end of these claims. The periods in the remaining claims are barely visible (see previous comments about size of text and facsimile transmissions).

Claim 1 is indefinite because it contains an optional limitation, "an optional second attachable container." The metes and bounds of the claim, that is, the scope of the claim can not be determined since it can't be determined if the second attachable container is part of the claim or not.

Claim 1 recites the limitation "the adjoining interface" in line 8. There is insufficient antecedent basis for this limitation in the claim.

Claim 1 recites the limitation "the cart, frame, or vertically extending handle" in line 13. There is insufficient antecedent basis for this limitation in the claim.

Claim 1 is indefinite for claiming "a single rigid entity" in line 21 after claiming a "single rigid entity in line 10. It can't be determined if the first stated single rigid entity is the same as the second. It would seem that since all three containers the wheeled container, the first

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attachable container and the second attachable container are rigidly connected that only one entity exists. However, applicant claims "first said rigid entity" and "a second said rigid entity" in claim 3 as if these two entities are not connected until the means for hitching was introduced. This is confusing and most indefinite.

Claim 3 recites the limitation "first said rigid entity" which has been interpreted as said first rigid entity in lines 1 and 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 3 recites the limitation "second said rigid entity" which has been interpreted as said second rigid entity in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claims 7, 17 and 21 refer to U.S. patent 4,691,840 to Ferbrache. The specific limitations found or described in Ferbrache must be inserted into the respective claim. Reference to a patent should never appear in a claim since the metes and bounds of the claim can't be determined. Claims 7, 17 and 21 are indefinite.

Claim 12 is indefinite because the phrase "a plurality of attachable containers" is not sufficiently different from the phrase "at least one attachable container" appearing in claim 11. It can't be determined if the plurality includes the at least one attachable container or if the plurality are all in addition to the at least one attachable container.

Claim 13 refers to the method of claim 10, wherein claim 10 is directed to the system and never refers to any method. Claim 13 recites the limitation "the method" in line 1. There is insufficient antecedent basis for this limitation in the claim. The preamble of claim 13 must match the preamble of the claim from which it depends, i.e., claim 10.



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Claim 23 contains the trademark/trade name RUBBERMAID. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a plastic trash receptacle and, accordingly, the identification/description is indefinite.

### ***Art Rejections***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3-6, 9-12 and 22 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Tiramani et al. ('559)(Tiramani 1) and Tiramani et al. ('847)(Tiramani 2).

Claim 21 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Ferbrache.

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tiramani 1 and Tiramani 2.

Each of the Tiramani references disclose the invention except for capacity of the container of 32 gallons. Trash containers of 32 gallon capacity are well known. It would have been obvious by design choice to modify the size of the container to be 32 gallons in order to make the volume correspond to any quantity desired. No criticality has been assigned to the 32 gallon capacity.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tiramani 1 or Tiramani 2 in view of Ferbrache.

The Tiramani references disclose the invention except for the specific handle of Ferbrache. Ferbrache teaches the handle of Ferbrache. It would have been obvious to modify the connection between the containers to be the handle of Ferbrache in order to provide a means for easy lifting by handle grasping, as well as, a latch in the same assembly to enhance the transportability and storage without adding parts.

Claims 13-16 and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tiramani 1 and Tiramani 2 in view of Tolbert, Jr. (Tolbert).

The Tiramani references disclose the invention except for the additional wheeled container secured to an attached container. From the Tiramani references, it is well known that

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the combination of a wheeled container with an attachable container is old and well known.

Tolbert teaches a plurality of side-by-side wheeled containers which are connected by their handles and roll together as a single entity in a tilted position. It would have been obvious to add another wheeled container with an attachable container by duplication of part and as taught by the Tiramani references and to connect the two wheeled containers by their handles as taught by Tolbert to provide a single entity which can be rolled in a tilted position as a single entity eliminating the need to make a trip with each container individually to transport all the containers to the same point from the same point.

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tiramani 1 or Tiramani 2 in view of Tolbert as applied to claim 16 above, and further in view of Ferbrache.

The combination disclose the invention except for the specific handle of Ferbrache. Ferbrache teaches the handle of Ferbrache. It would have been obvious to modify the connection between the containers to be the handle of Ferbrache in order to provide a means for easy lifting by handle grasping, as well as, a latch in the same assembly to enhance the transportability and storage without adding parts.

Note that applicant states that the species contained in this application are not patentably distinct and unpatentable over each other in lines 8-10 of the request for supervisory review filed February 3, 2003 as paper No.23. The claims are additionally obvious for this reason.


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*Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen J. Castellano whose telephone number is 703-308-1035. The examiner can normally be reached on M-Th 6:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lee W. Young can be reached on 703-308-2572. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

  
Stephen J. Castellano  
Primary Examiner  
Art Unit 3727

sjc  
March 13, 2003